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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,999	12/09/2003	M. Alain Cadic	025200-042	3905

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EXAMINER

PARA, ANNETTE H

ART UNIT PAPER NUMBER

1661

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,999	CADIC, M. ALAIN	
	Examiner	Art Unit	
	Annette H. Para	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/19/2005</u> | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by French Plant Breeder's Right application number 16201 published on May 20, 1998, four-page leaflet entitled "Sapho Infos" 1999 (Exhibit C of parent application number 09/791, 738), in view of applicant's admission that 'Inoveris' was first publicly available in France on July 1999 (page 4 of reply dated August 29, 2002), more than one year prior to the effective filing date of this instant plant application. The application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128.

Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 USC 102(b) must be enabling. The text of the relied upon publication standing alone would not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied on to show that the primary reference has an "enabled disclosure." *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). See also MPEP § 2131.01. When the claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the

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United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the 'Siokra' cultivar disclosed in the cited publications." See also MPEP § 2121.03. Moreover, the Court in *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states that a printed publication coupled with a foreign sale of the plant would constitute a bar under §102(b) on page 1040.

Applicant states on pages 4 of reply dated July 19, 2005 that the information to 37 CFR 1.105 was provided in the parent Application No. 09/791,738 dated August 26, 2002, which discloses that the instant plant was first available in a foreign country, more than one year prior to the effective filing date of the instant plant application. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. One of ordinary skill in the art would have known where to obtain the claimed plant because UPOVROM discloses the breeder as GIE Saphinov <<http://www.angers.inra.fr/dossiers/SAPHOSalonveg2004.pdf> > and one could have contacted GIE Saphinov by phone: 02 41 51 91 20, or e-mail: olivier.pantin@wanadoo.fr. With that contact information, one of ordinary skill in the art could check the availability of the claimed plant and where to purchase the plant. With regard to the reproducibility of the instant cultivar, a person skilled in the art would have the knowledge of reproducing the instant cultivar, given the notoriety of various methods of asexual propagation of a caryopteris as shown in The New Royal Horticultural Society Dictionary Of Gardening Vol.1 page 528.

Response to Arguments

Applicant stated on July 19, 2005 that the cultivar Inoveris was disclosed in the French Breeders Rights Application No. 16201, and a leaflet edited by Andre Briant dated October, 1999 and they argue that there has been a misapplication of the statute under 35 U.S.C. §102(b) because one skilled in the art could not reproduce the instant cultivar from a publication, more than one year prior to the effective filing date of the instant application.

Applicant's arguments filed on July 05, 2005 have been fully considered but they are not persuasive.

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Examiner agrees that no one can reproduce any plant from a publication; however, in this instant application the basis of the 102(b) rejection is the published document coupled with the foreign sale of the instant plant more than one year prior to the effective filing date of this application. In *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004), the Court states the following on page 1039:

Plant Breeder's Rights applications published more than one year before effective filing dates of applications for plant patents are proper anticipatory references that may bar patentability of claimed plants under 35 U.S.C. § 102(b), even though PBR applications disclose claimed plant varieties but do not, by themselves, enable skilled artisan to practice claimed inventions or reproduce claimed plants, since public may have had access to claimed inventions through foreign sales of plants, from which claimed plants may be reproduced, and since secondary reference may be used to show that primary Section 102(b) reference was in fact enabled; although foreign sales are not prior art, precise issue is whether publication of PBR applications placed claimed inventions in possession of public before critical date, and foreign sales of claimed plants may be within knowledge of skilled artisan and may be considered to provide public with access to applicant's inventions.

The instant cultivar was described in the published PBR applications more than one year before the effective filing date of the application for plant patent and the public had access to the instant cultivar because the Applicant admits that the instant cultivar was available to the public on July, 1999 in France as is also documented in the 1999 the leaflet "Sapho Infos" more than one year prior to the effective filing date of the instant plant application.

Applicant argues that *In re LeGrice* is the controlling authority and must be followed by the Examiners. This argument has been fully considered, however, is not persuasive because in *LeGrice*, the Applicant never admitted the sale of the rose plants, and this issue was not considered in *LeGrice*. In *Elsner*, the Court agreed with the Office "there was no mention of sales in the *LeGrice* opinion" (page 1043). However in this situation, the Applicant admitted the claimed plant was in the public domain, more than one year prior to the effective filing date of this instant application, therefore, one skilled in the art could have possession of the claimed plant.

Applicant argues that public use and availability in a foreign country, more than one year before the filing date is not an impediment to U.S. Patent protection. This argument has been fully considered, however, is not persuasive because as stated above the basis of this rejection is the published document combined with the foreign sale of the claimed plant. In *Elsner*, The Court states the following, "Because

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the published applications, combined with the foreign sales of the plants, placed the claimed inventions in the possession of the public, we therefore hold that they are proper §102(b) anticipatory references that may bar patentability."

Applicant argues that the *LeGrice* decision by Judge Smith with regard to when a printed publication can serve as a statutory bar had been properly applied and had been followed by the Patent Office for decades. This argument has been fully considered, however, is not persuasive because in *LeGrice* the Appellant never admitted the sale of the rose plants and this was not an issue before the Court.

Applicant argues that the 102(b) rejection in *Ex parte Thomson* had been misapplied because that case involved a utility application. This argument has been fully considered, however, is not persuasive because the standards in utility and plant patents are the same. 35 U.S.C. 161 and 37 C.F.R. 1.161 both state that patents for inventions shall apply to patents for plants, except as otherwise provided.

Applicant then argues that both *Thomson* and *LeGrice* cases had public use and availability of the plant material outside of the U.S., more than one year prior to the U.S. filing dates. This argument has been fully considered, however, is not persuasive because in *Thomson*, the Appellant admitted the availability of Siokra seeds. In *LeGrice*, there was no indication of the commercial availability.

Applicant further argues that there is no way that a person skilled in the art could reproduce the claimed plant from a published document. Examiner agrees that no one could reproduce any plant from a printed document. As stated above the basis for this rejection is the published PBR document and the availability of the claimed plant enables the publications.

Applicant argues that the Examiner has no authority for asserting that the availability of claimed plant outside of the U.S. combined with a non-enabling publication has ever been a bar to patentability. This argument has been fully considered, however, is not persuasive because the sale or public availability is the secondary evidence that the primary reference is an "enabled disclosure" (See MPEP 2131.01). The availability of the claimed plant anywhere is evidence of an enabling disclosure. *In re Samour* and *In re Donohue* both say that other evidence can be used to show that the publication was enabled. In *Donohue*, 226 USPQ 622 the Courts state, "The purpose of citing Lincoln and Wagner is,

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instead, to show that the claimed subject matter, as disclosed in Nomura, was in the public's possession. *Id.* Therefore, the anticipation rejection based on Nomura, Lincoln, and Wagner is proper." *In re LeGrice* states, "public use and sale of a plant are the avenues by which a plant enters the public domain" (133 USPQ 371). Then *LeGrice* states, "The mere description of the plant is not necessarily an 'enabling' disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those skilled." The same arguments were presented in *Ex parte Thomson*, in which the Siokra seeds described in the cited publications were commercially available to the public more than one year prior to filing of the application. In this case, the public was in possession of the claimed plant and the PBR publication is enabled because of the availability of the claimed plant in France on September 1998 to one of ordinary skill in the art and the ability of one of ordinary skill in the art to asexually reproduce the plant without undue experimentation as shown by the Royal Horticultural Dictionary reference.

Applicant argues that the Court in *In re Elsner* had no authority under the U.S. Constitution to seek a change in the content of 35 U.S.C. §161. This argument has been fully considered, however, is not persuasive because the Court in *Elsner* was conveying that there is a distinction between a utility and plant patent. The distinction for a plant patent to be granted is that it must be "[w]hoever invents or discovers and asexually reproduce any distinct and new variety of plant..." 35 U.S.C. §161 (2000). A utility patent does not have that distinction. Therefore, a publication is enabled by the foreign sale of the plant that places a skilled artisan in possession of the plant and then asexually reproduce the plant would constitute a bar under §102(b).

Finally, Applicant argues that the availability of a claimed invention in a foreign country more than one year prior to the filing of a U.S. Patent Application does not constitute "prior art" under 35 U.S.C. §102. This argument has been fully considered, however, the argument does not apply because the Court in *Elsner* states, "However, the precise focus of the analysis is not whether the foreign sales are themselves §102(b) prior art, but whether the publication has placed the claimed invention in the possession of the public before the critical date" (page 1042). In this case, the claimed plant was

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available to the public on July 1999 in France, more than one year prior to the effective filing date of this U.S. Plant Patent application for which the public may have access to the claimed plant.

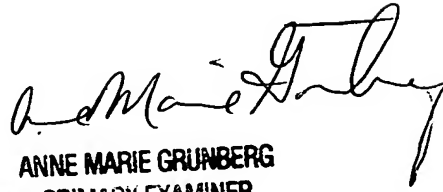
Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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ANNE MARIE GRUNBERG
Supervisory PRIMARY EXAMINER